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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92050260
Party	Defendant STW ACQUISITION CORP.
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Submission	Other Motions/Papers
Filer's Name	Scott Greenberg
Filer's e-mail	sgreenberg@lockelord.com
Signature	/Scott Greenberg/
Date	03/11/2009
Attachments	Respondents_Motion_To _Dismiss_And, In_The_Alternative_For_Judgment_On_The_Pleadings.pdf (18 pages)(746950 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Registration No. 1,358,531
For the mark: WOK & ROLL
Registered: September 3, 1985

Wok n' Roll Express, Inc Petitioner, v. STW Acquisition Corp. Respondent	:	Cancellation No. 92050260

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

RESPONDENT'S MOTION TO DISMISS AND, IN THE ALTERNATIVE, FOR JUDGMENT ON THE PLEADINGS

Respondent STW Acquisition Corp. ("Respondent") hereby moves pursuant to Federal Rules of Civil Procedure 12(b)(6) and 12(c), and Trademark Rule 2.116(a) (37 CFR §2.116(a)), to dismiss the Petition For Cancellation ("Cancellation Petition") filed by Wok n' Roll Express, Inc. ("Petitioner") for failure to state a claim upon which relief can be granted and, in the alternative, for a judgment on the pleadings dismissing the Cancellation Petition.

Petitioner alleges, as its sole ground for cancellation, that the statements made in the combined declaration of use and application for renewal executed by Respondent on May 4, 2005 and filed on May 23, 2005 in the subject registration (the "'2005 Renewal Application"), as well as the execution and filing of the 2005 Renewal Application, constituted false or fraudulent information. The basis for Petitioner's allegation is that Respondent's state of

incorporation (New York State) had previously issued a proclamation of dissolution, which has since been annulled on a nunc pro tunc basis.

This ground for cancellation is without basis because a registrant's corporate status with its state of incorporation at the time of filing documents in connection with its registration is an ex parte matter and not an appropriate ground for cancellation. Therefore, the Cancellation Petition should be dismissed for failure to state a claim upon which relief can be granted.

In the alternative, the Board should grant judgment on the pleadings dismissing the Cancellation Proceeding because the undisputed facts and controlling law establish that Petitioner's allegations of fraud in connection with the 2005 Renewal Application are meritless as a matter of law. The undisputed facts are demonstrated by the Cancellation Petition, Respondent's Answer filed concurrently with this motion, and the attached certificate from the official records of the State of New York, of which the Board may take judicial notice.

It is undisputed that on June 26, 2002 New York State issued a proclamation of dissolution of Respondent corporation. However, on December 1, 2008 that proclamation of dissolution of Respondent was annulled by New York State and the corporation was revived, reinstated and continued. Under New York law (New York Tax Law §203-a(7)), by virtue of its reinstatement, Respondent has all corporate powers and rights as it had on the date of the proclamation of dissolution as if that proclamation had never been made, and actions taken by the reinstated corporation prior to the reinstatement are retroactively valid. Therefore, under the controlling law, the previous, now nullified proclamation of dissolution did not in any way make Respondent's 2005 Renewal Application false, fraudulent or improper. Petitioner's contrary allegations are thus untenable and meritless as a matter of law.

It is well established that there can be no claim of fraud in conjunction with a trademark application or registration in the absence of a false statement of material fact. American Flange & Manufacturing Co. v. Rieke Corp., 80 USPQ2d 1397, 1415 (TTAB 2006). Here, the parties' pleadings, the undisputed facts and controlling law establish that there has been no false statement of a material fact.

I. PETITIONER'S CLAIMS FOR CANCELLATION AND THE APPLICABLE UNDISPUTED FACTS

A. THE CLAIMS FOR CANCELLATION ARE BASED ENTIRELY ON RESPONDENT'S CORPORATE STATUS IN 2005

The sole ground for the Cancellation Petition is Petitioner's allegation that certain statements made by Respondent in its 2005 Renewal Application, as well as the execution and filing of the 2005 Renewal Application, constituted "false information." (Paragraph 5 of the Cancellation Petition). Petitioner's cover sheet states that "Fraud" is the ground for cancellation.

The sole basis for this claim of false or fraudulent information in connection with the 2005 Renewal Application is Petitioner's allegation regarding Respondent's corporate status at the time of the 2005 Renewal Application. Specifically, the Cancellation Petition makes the following allegations:

1. Allegations Regarding Statements Of Use Of The Mark In 2005 Renewal Application

- "The Registrant was not using the mark, since the corporation was not eligible to do business, and according to the New York State website is still inactive" (Paragraph 5(1) of the Cancellation Petition).
- Respondent's mark was "renewed under the false pretense...that the Registrant/Owner was using the mark in commerce, when in fact the Registrant/Owner, could not, according to the records of the State of New York conduct any business... ." (Paragraph 7 of the Cancellation Petition).

2. Allegations Regarding Execution And Filing Of 2005 Renewal Application

- Mr. Ben T. Wong, who signed the Renewal Application as President of Respondent, "did not have authorization to sign the declaration and make the statements he made since there was no active corporate entity at the time the statements were made, for whom he was acting." (Paragraph 5(2) of the Cancellation Petition).

- Respondent's mark was renewed under the false pretense that the Registrant/Owner was a valid corporation at the time the declaration was signed... ." (Paragraph 7 of the Cancellation Petition).

As demonstrated below, all of these allegations based on corporate status are incorrect and meritless as a matter of law.

B. THE UNDISPUTED FACTS AND NEW YORK LAW SHOW THAT THE PRIOR ADMINISTRATIVE DISSOLUTION HAS BEEN ANNULLED, AND RESPONDENT HAS BEEN REINSTATED TO ACTIVE STATUS AS IF THE DISSOLUTION NEVER OCCURRED

On June 26, 2002, the New York Secretary of State issued a proclamation dissolving Respondent, a New York corporation, due to a delinquency in the payment of taxes under the New York Tax Law. However, Respondent has paid the taxes that were owed and accordingly, the New York Commissioner of Taxation and Finance issued a certificate of consent that was filed with the New York Department of State on December 1, 2008. Attached to this motion as Exhibit 1 is a certified copy of a certification, certified by Daniel Shapiro, Special Deputy Secretary of State of the State of New York, that the proclamation of dissolution of the Respondent corporation was annulled and the existence of the Respondent revived, reinstated and continued by the above-mentioned certificate that was duly filed in the New York Department of State on December 1, 2008.

Pursuant to §203-a(7) of the New York Tax Law, due to this reinstatement of Respondent's active corporate status, Respondent again has the same corporate powers and

rights that it had on the date of the proclamation of dissolution "with the same force and effect as if such proclamation had not been made or published." A copy of §203-a of the New York Tax Law is attached to this motion as Exhibit 2. Under New York law, this reinstatement restored Respondent's corporate status nunc pro tunc, and its prior corporate actions are retroactively validated. See, e.g., L-Tec Electronic Corp. v. Cougar Electronic Organization, Inc., 198 F.3d 85, 87 (2d Cir. 1999) ("[W]here the corporation later pays its taxes and is reinstated, it corporate status is restored nunc pro tunc, and any contracts into which it may have entered are retroactively validated.").

II. THE CANCELLATION PETITION SHOULD BE DISMISSED FOR FAILURE TO STATE A CLAIM UPON WHICH RELIEF CAN BE GRANTED

A claim for cancellation must be dismissed under Fed. R. Civ. P. 12(b)(6) if it is "fatally flawed in [its] legal premises and destined to fail...thus to spare litigants the burdens of unnecessary pretrial and trial activities." Advanced Cardiovascular Systems, Inc. v. SciMed Life Systems Inc., 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993); TBMP §503.02.

Here, the Cancellation Petition is fatally flawed in its legal premises and destined to fail because it is based entirely on an alleged invalidity of the 2005 Renewal Application due to the status of Respondent's corporation with New York State. The Board has held that such allegations of invalidity of a renewal application or declaration of use based on the registrant's corporate status are "an ex parte matter, and not an appropriate ground for cancellation." Hayhurst v. American Association of Naturopathic Physicians, 2001 TTAB LEXIS 730 at *5 (TTAB 2001) (dismissing claim for cancellation based on alleged invalidity of Section 8 and 15 declaration filed when registrant corporation was administratively dissolved by its state of incorporation). A copy of the Hayhurst decision is attached to this motion as Exhibit 3.

Because Petitioner's claims are not an appropriate ground for cancellation, the cancellation petition is fatally flawed in its legal premises and destined to fail and therefore must be dismissed under Fed. R. Civ. P. 12(b)(6).

III. ALTERNATIVELY, THE BOARD SHOULD GRANT JUDGMENT ON THE PLEADINGS DISMISSING THE CANCELLATION PETITION

Generally, the Board should grant judgment on the pleadings under Fed. R. Civ. P. 12(c) dismissing a petition to cancel, when the undisputed facts appearing in the parties' pleadings, supplemented by any fact of which the Board will take judicial notice, demonstrate that the Respondent is entitled to judgment on the substantive merits of the controversy as a matter of law. TBMP §504.02.

As demonstrated above, Petitioner's claims of false information in connection with the 2005 Renewal Application are based entirely on New York's 2002 proclamation of dissolution of Respondent. Petitioner does not claim that Respondent made any expressly false statements. Instead, Petitioner is, in effect, alleging that Respondent's statement in the 2005 Renewal Application that it was using the subject mark, was false by implication "since the corporation was not eligible to do business" (Paragraph 5(1)), and "Registrant/Owner, could not, according to the records of the State of New York conduct any business... ." (Paragraph 7). Petitioner similarly alleges that the execution and filing of the 2005 Renewal Application was done under "false pretenses" because Respondent was not "a valid corporation at the time the declaration was signed." (Paragraph 7).

However, the undisputed facts shown in the Cancellation Petition, Respondent's Answer filed concurrently herewith, and the New York State certification of reinstatement and annulment of dissolution attached to the Answer as Exhibit A and to this Motion as Exhibit 1, establish that the 2002 proclamation of dissolution was annulled and the existence of the Respondent revived,

reinstated and continued as of December 1, 2008. It is well established that, under Federal Rule of Evidence 201(b), judicial notice may be taken of the information in a public corporate record such as the reinstatement of Respondent certified in Exhibit 1. See Reiner v. Washington Plate Glass Co., 711 F2d 414, 416 (D.C. Cir. 1983) (taking judicial notice of dates on which a corporation was incorporated, surrendered its corporate charter, and reincorporated, from records filed in District of Columbia Recorder of Deeds Office); United States v. Wood, 925 F.2d 1580, 1582 (7th Cir. 1991) (district court may take judicial notice of matters of public record in motion for judgment on pleadings).

Due to this reinstatement of Respondent's active corporate status, Respondent again has the same corporate powers and rights that it had on the date of the proclamation of dissolution "with the same force and effect as if such proclamation had not been made or published." §203-a(7) of the New York Tax Law (Exhibit 2). This reinstatement restored Respondent's corporate status nunc pro tunc, and its prior corporate actions are retroactively validated. See, e.g., L-Tec Electronic Corp. v. Cougar Electronic Organization, Inc., 198 F.3d 85, 87 (2d Cir. 1999) ("[W]here the corporation later pays its taxes and is reinstated, its corporate status is restored nunc pro tunc, and any contracts into which it may have entered are retroactively validated.").

The Board has recognized this form of retroactive validation in other cases. In Hayhurst, in addition to noting that such allegations of invalidity based on corporate status are an ex parte matter and not an appropriate ground for cancellation, the Board also held that the cancellation claim in that case was meritless because the registrant corporation therein was reinstated and, under the law of its state, the pre-reinstatement filing of the declaration of use was retroactively

validated and "was an activity appropriately undertaken by Respondent." 2001 TTAB LEXIS 730 at *7.

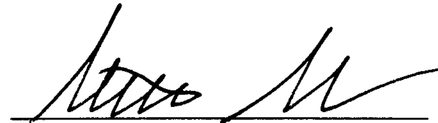
Thus, the undisputed facts and controlling law establish that, as a matter of law, Respondent was entitled to act within its corporate rights and powers in 2005 notwithstanding the now nullified 2002 proclamation of dissolution. Respondent's filing of the 2005 Renewal Application and statements therein that it was using the subject mark are therefore not in any way rendered false, fraudulent or invalid by the annulled proclamation. Petitioner's claim to the contrary must be dismissed as a matter of law.

For the reasons set out above, Respondent respectfully requests that its motion to dismiss and, in the alternative, for judgment on the pleadings be granted.

Respectfully submitted,

Locke Lord Bissell & Liddell LLP

Dated: March 11, 2009

By: 

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Attorneys for Respondent

EXHIBIT 1

State of New York
Department of State } ss:

I hereby certify, that the Certificate of Incorporation of STW ACQUISITION CORP. was filed on 07/27/1998, with perpetual duration, and that a diligent examination has been made of the Corporate index for documents filed with this Department for a certificate, order, or record of a dissolution, and upon such examination, no such certificate, order or record has been found, and that so far as indicated by the records of this Department, such corporation is an existing corporation. I further certify the following:

A Biennial Statement was filed 08/28/2000.

It was dissolved by proclamation of the Secretary of State published on 06/26/2002 pursuant to the Tax Law.

Such dissolution proceedings were annulled and the existence of the corporation revived, reinstated and continued by a certificate duly filed in this Department 12/01/2008 pursuant to the Tax Law.

The Biennial Statement is past due.

I further certify, that no other documents have been filed by such Corporation.

***

Witness my hand and the official seal of the Department of State at the City of Albany, this 27th day of February two thousand and nine.

Daniel Shapiro
Special Deputy Secretary of State

200903020209 * EZ

EXHIBIT 2

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*** THIS SECTION IS CURRENT THROUGH CH. 652, 1/27/2009 ***

TAX LAW
ARTICLE 9. CORPORATION TAX

Go to the New York Code Archive Directory

NY CLS Tax § 203-a (2008)

§ 203-a. Dissolution of delinquent business corporations

1. On or before the last day of March, June, September or December in each calendar year, the tax commission may certify and transmit to the department of state a list containing the names of any or all such stock corporations and corporations formed for profit, other than corporations formed by or under special acts and other than banking, insurance and railroad corporations, as have not filed reports required under this article during the period of two consecutive years next preceding the date of such certification or as have been delinquent in the payment of taxes for any two years duly assessed pursuant to this article.

2. If the secretary of state, upon comparing the names so certified with his records, shall discover error, he may return the list to the tax commission for correction.

3. The secretary of state shall make a proclamation under his hand and seal of office, as to the corporations whose names are included in such list as finally corrected, declaring such corporations dissolved and their charters forfeited pursuant to the provisions of this section. He shall file the original proclamation in his office and shall publish a copy thereof in the state bulletin no later than three months following receipt of the list by him.

4. Upon the publication of such proclamation in the manner aforesaid, each corporation named therein shall be deemed dissolved without further legal proceedings.

5. The secretary of state shall mail a copy of the state bulletin containing such proclamation to the clerk of each county in the state. The county clerk shall file the copy without charge but need not record it.

6. The names of all corporations so dissolved shall be reserved for a period of three months immediately following the publication of the proclamation, and during such period no corporation shall be formed under a name the same as any name so reserved or so nearly resembling it as to be calculated to deceive, nor shall any foreign corporation, within such period, be authorized to do business in this state under a name the same as any name so reserved or so nearly resembling it as to be calculated to deceive.

7. Any corporation so dissolved may file in the department of state a certificate of consent of the [fig 1] commissioner

of taxation and finance. Such certificate of consent shall be given only if the commissioner of taxation and finance ascertains that all [fig 2] fees and taxesimposed under this chapter or any related statute, as defined in section eighteen hundred of this chapter, as well as penalties and interest charges related thereto, accrued against [fig 3] the corporation have been paid. The filing of such certificateof consent shall have the effect of annulling all of the proceedings theretofore taken for the dissolution of such corporation under the provisions of this section and it shall thereupon have such corporate powers, rights, duties and obligations as it had on the date of the publication of the proclamation, with the same force and effect as if such proclamation had not been made or published. The fee of the secretary of state for filing such certificate shall be fifty dollars and if it is filed later than three months after the date of publication of the proclamation the secretary of state shall collect a further sum equal to one-fortieth of one percentum of all shares with par value and two and one-half cents for every share without par value which such corporation was authorized to have at the time of such publication. No such certificate shall be filed if the name of the corporation is the same as, or so nearly resembles as to be calculated to deceive, that of a domestic corporation formed later than three months after the publication of the proclamation of dissolution or of a foreign corporation which has obtained authority to do business in the state later than three months after such proclamation unless there is simultaneously filed in the department of state a certificate of change of name. Such certificate of change of name shall be executed in like manner as if such corporation had not been dissolved. Any corporation dissolved pursuant to this section and desiring to annul the dissolution proceedings later than three months from the date of proclamation of dissolution, may, if such name is still available, pay to the secretary of state the fees hereinbefore in this subdivision mentioned, or may submit with such payment a written application requesting the reservation of another available name, and thereupon the secretary of state shall reserve such name for a period of thirty days from the date of such payment to permit the completion of such annulment. No moneys so paid shall in any event be returned by the secretary of state.

8. If, after the publication of such proclamation, it shall appear that the name of any corporation was erroneously included therein, the state tax commission shall so certify to the secretary of state, and the secretary of state shall make appropriate entry on the records of the department of state, which entry shall have the effect of annulling all of the proceedings theretofore taken for the dissolution of such corporation under the provisions of this section, and it shall have such corporate powers, rights, duties and obligations as it had on the date of the publication of the proclamation, with the same force and effect as if such proclamation had not been made or published.

9. Whenever a corporation shall have complied with subdivision seven of this section, or whenever the proceeding specified in subdivision eight of this section shall have been taken, the secretary of state shall publish a notice thereof in the state advertising bulletin and shall send a copy of such bulletin to the county clerk of the county in which, according to his records, the office of the corporation is located. Such county clerk shall file such copy and make appropriate entry on his records without charge.

10. The provisions of section twenty-nine of the general corporation law shall apply to any corporation heretofore or hereafter dissolved under this section except for those corporations governed by the business corporation law as to which section one thousand nine of such law shall apply.

HISTORY: Add, L 1929, ch 297; amd, L 1931, ch 337, § 1.
Sub 1, amd, L 1935, ch 38, L 1975, ch 494, L 1978, ch 180, eff May 23, 1978.
Sub 3, amd, L 1978, ch 180, eff May 23, 1978.
Sub 4, amd, L 1940, ch 197, eff May 19, 1940.
Sub 5, amd L 1978, ch 180, eff May 23, 1978.
Sub 7, amd L 1937, ch 667, L 1957, ch 376, eff April 11, 1957.
Sub 8, amd, L 1930, ch 16, eff Feb 10, 1930, retroactive to April 5, 1929.
Sub 9, amd, L 1933, ch 474, eff Apr 26, 1933, retroactive to April 5, 1929.
Sub 10, amd, L 1940, ch 82, L 1941, ch 590, L 1964, ch 100, eff March 16, 1964.
Sub 7, amd, L 1990, ch 190, § 3, eff Sept 1, 1990 (see 1990 note below).
The 1990 act deleted at fig 1 "tax commission", at fig 2 "franchise" and at fig 3 "it"

EXHIBIT 3

LEXSEE

Donald C. Hayhurst, N.M.D., Ph.D. v. American Association of Naturopathic Physicians (Oregon corporation)

Cancellation No. 29,464

Trademark Trial and Appeal Board

2001 TTAB LEXIS 730

September 27, 2001, Decided

CORE TERMS: dissolution, reinstatement, registration, dissolved, summary judgment motion, summary judgment, facts sufficient, effective date, administratively, cancellation, continuously, declaration, abandoned, cancelled, cancel, statue, executive director, statute relating, null and void, case law, naturopathic, abandonment, challenging, conducting, reinstated, ownership, carrying, damaged, resumes

JUDGES: [*1]

Before Seeherman, Hanak and Hairston, Administrative Trademark Judges.

OPINION BY: HAIRSTON

OPINION:

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Opinion by Hairston, Administrative Trademark Judge:

Donald C. Hayhurst, N.M.D., Ph.D. [petitioner], has petitioned to cancel a registration owned by American Association of Naturopathic Physicians [respondent or "Association I"] for the mark AMERICAN ASSOCIATION OF NATUROPATHIC PHYSICIANS for "association services, namely, promoting the interest of naturopathic physicians." n1 In the petition for cancellation, it is alleged that:

> American Association of Naturopathic Physicians incorporated in the state of Oregon on 12/17/98 ["Association II"] comes challenging the continued registration by the U.S. Patent and Trademark Office of Registration No. 1,750,559 as its continuance will severely damage efforts to conduct business due to longstanding feud and history with Donald Hayhurst, and now another newly formed group will be harmed.

n1 Registration No. 1,750,559 issued February 2, 1993 under the provisions of Section 2(f); Section 8 & 15 affidavit filed. The words "NATUROPATHIC PHYSICIAN" have been disclaimed apart from the mark as shown.

[*2]

As grounds for cancellation, it is alleged that Association I was dissolved by the Oregon Secretary of State on March 26, 1998; that Association I was thereafter prohibited from conducting any activities, including the filing of an affidavit of use under Section 8 and 15; and that the Section 8 and 15 declaration filed by Association I on January 15, 1999 is therefore null and void. In addition, it is alleged that as a result of Association I's dissolution, said association has abandoned the mark which is the subject of the involved registration and that Association II is now the prior user of the mark.

Respondent, in its answer, has denied the allegations of the petition to cancel. As affirmative defenses, respondent asserts that the petition fails to state a claim upon which relief can be granted, that petitioner lacks standing to bring the petition, and that the alleged "prior use" of the mark by Association II has been held to be an infringement of respondent's mark.

This case now comes up on respondent's motion for summary judgment. Petitioner has filed a brief in response thereto.

First, respondent argues that petitioner has failed to plead his standing in this proceeding, [*3] that is, petitioner has failed to plead that he has any ownership or interest in Association II, the entity that he alleges will be damaged by continued registration of the involved mark.

Second, respondent argues that on February 27, 1999 it was reinstated as a corporation in the State of Oregon, and that under the relevant Oregon statue, this reinstatement operates nunc pro tunc from the date of dissolution. In particular, respondent maintains that the legal effect of the reinstatement was as if the dissolution never occurred, and therefore, its filing of a Section 8 and 15 affidavit was proper. Finally, respondent maintains that it has continuously used the mark which is the subject of the registration sought to be cancelled, and the fact that respondent was dissolved at one point does not mean that the mark was abandoned. In support of its summary judgment motion, respondent has submitted the declaration of its executive director Sheila Quinn, a copy of the pertinent Oregon statue relating to reinstatement of a corporation, and several other exhibits.

Petitioner, in response to the summary judgment motion, states that respondent is well aware of petitioner's interest in the [*4] involved mark because petitioner is a Naturopath and a leader of Naturopathic organizations, schools and conferences. Further, petitioner maintains that the Oregon statute relating to dissolution of a corporation expressly prohibits a dissolved corporation from conducting any activities except those necessary to wind up and liquidate its affairs; and that once respondent was dissolved it was prohibited from filing the Section 8 and 15 affidavit. Respondent maintains that there is no Oregon case law interpreting the statue relating to reinstatement of a corporation and that the case law of other states must be looked to for guidance.

A party is entitled to summary judgment when it has demonstrated that there are no genuine issues as to any material facts, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). The evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. Opryland USA, Inc. v. Great American Music Show, Inc., 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1993).

We turn first to the issue of abandonment. Respondent's [*5] executive director, Sheila Quinn, asserts in her declaration that respondent has continuously used the mark which is the subject of the registration sought to be cancelled on newsletters and correspondence and in connection with conventions and meetings throughout the United States.

Petitioner, in its response to respondent's motion for summary judgment, makes no mention of the issue of abandonment, and has offered no evidence to dispute Ms. Quinn's assertions that respondent has continuously used the involved mark. In view thereof, we find that there is no genuine issue that respondent has not abandoned the mark.

Further, with respect to petitioner's allegation that respondent's Section 8 and 15 affidavit is null and void, it is noted that this is an ex parte matter, and not an appropriate ground for cancellation. However, to the extent that petitioner is arguing that respondent did not meet the Section 8 requirement that the mark be currently in use in commerce, such argument is not well-taken in view of our finding that respondent did not abandon the involved mark. Moreover, accompanying Ms. Quinn's declaration is a copy of the Oregon statute relating to reinstatement of a dissolved [*6] corporation, which is set forth below:

ORS § 65.654 (1997)

65.654. Reinstatement following administrative dissolution.

(1) A corporation administratively dissolved under ORS 65.651 may apply to the Secretary of State for reinstatement within five years from the date of dissolution. The application must:

(a) State the name of the corporation and the effective date of its administrative dissolution; and

(b) State that the ground or grounds for dissolution either did not exist or have been eliminated.

(2) If the Secretary of State determines that the application contains the information required by subsection (1) of this section, that the information is correct, and that the corporation's name satisfies the requirements of ORS 65.094, the Secretary of State shall reinstate the corporation.

(3) When reinstatement is effective, it relates back to and takes effect as of the effective date of the administrative dissolution and the corporation resumes carrying on its activities as if the administrative dissolution had never occurred.

This statute is plain on its face. Paragraph no. (3) thereof expressly states that the [*7] reinstatement of an administratively dissolved corporation "relates back to and takes effect as of the effective date of the administrative dissolution" and that "the corporation resumes carrying on its activities as if the administrative dissolution had never occurred." In this case, respondent was administratively dissolved on March 26, 1998 and was reinstated on February 27, 1999. Inasmuch as the reinstatement relates back to March 26, 1988, the Section 8 affidavit filed on January 15, 1999 was an activity appropriately undertaken by respondent.

Finally, we find that petitioner has not pleaded its standing in this case. Standing at the pleading stage is reviewed by determining whether petitioner has alleged facts, which if later proven, would establish that petitioner has a real interest in the proceeding. As noted by respondent, the pleading alleges that Association II, not petitioner, is "challenging" the involved registration. Moreover, as noted by respondent, there is nothing in the pleading that indicates that petitioner has any ownership or interest in Association II. Thus, the pleading fails to set forth how petitioner is damaged by the continued existence of the registration [*8] sought to be cancelled. It is not enough that respondent supposedly knows of petitioner's "interest" in the involved mark; rather, the pleading must specifically set forth facts sufficient to show petitioner's interest in the proceeding. We note in this regard that accompanying respondent's summary judgment motion is a copy of an order and permanent injunction issued by the United States District Court for the Western District of Washington in a proceeding involving the petitioner, Association II and respondent. The Court enjoined petitioner from using the mark AMERICAN ASSOCIATION OF NATUROPATHIC PHYSICIANS and any "colorable derivation" thereof. It appears, therefor, that petitioner is unable to allege facts sufficient to show an interest in this proceeding. Moreover, even if petitioner were able to plead facts sufficient to show an interest in this proceeding, it would be of no consequence because it has lost on the substantive grounds.

In view of the foregoing, respondent's motion for summary judgment is granted. The petition to cancel is dismissed.

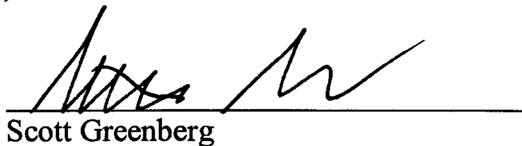
Legal Topics:

For related research and practice materials, see the following legal topics:
Trademark LawProtection of RightsGeneral OverviewTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsCancellationsGeneral Overview

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the attached RESPONDENT'S MOTION TO DISMISS AND, IN THE ALTERNATIVE, FOR JUDGMENT ON THE PLEADINGS was served by first class mail, postage prepaid, on this 11th day of March 2009 upon attorney of record for the Petitioner at the following address:

Marc N. Blumenthal, Esq.
Law Office of Marc N. Blumenthal
19 S La Salle Street, Suite 1500
Chicago, IL 60603-1413



Scott Greenberg

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